

Remarks

Amendments to the claims

Claims 1, 6, 10 and 13 have been amended, as indicated above. Support for the amendments is found in the specification and drawings as follows:

- Claims 1 and 6: page 12, lines 6-24; page 19, lines 1-19; and Fig. 8.
- Claims 10 and 13: Fig. 9A (first sheet 310, and second sheet 320); Fig. 8; page 19, lines 1-19.

No new matter has been added to the claims.

The amendments are being made herein are for the sole purpose of facilitating an understanding of the differences between the Applicant's claimed invention and the prior art, and are not to be considered as an admission that the prior art anticipated or rendered obvious the amended claims.

Rejection of Claims under 35 U.S.C. § 102

Claims 1-4, 10, 11 and 16 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 3,664,912 (hereinafter, "Olson"), as well as by Japanese Patent No. JP 08052827 (hereinafter, "Osogoshi").

The Applicant respectfully disagrees that claims 1-4, 10, 11 and 16 are anticipated by either Olson or Osogoshi.

As a starting point, the PTO and the Federal Circuit provide that §102 anticipation requires each and every element of the claimed invention to be disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990)). The corollary of this rule is that the absence from a cited §102 reference of any claimed element negates the anticipation. (*Kloster Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986)). Furthermore, "[a]nticipation requires that all of the elements and limitations of the claims are found within a single prior art reference." (*Scripps Clinic and Research Found. v Genetech. Inc.*, 927 F.2d 1565,

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1 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991 (emphasis added)). Moreover, the
2 PTO and the Federal Circuit provide that §102 anticipation requires that there must be
3 no difference between the claimed invention and the reference disclosure. (*Scripps*
4 *Clinic and Research Found. v. Genetech, Inc.*, id. (emphasis added)).

5 Accordingly, if the Applicant can demonstrate that any one element or limitation in
6 claims 1-4, 10, 11 and 16 is not disclosed by either Olson or Osogoshi, then the
7 respective claim(s) must be allowed.

8 In the following arguments, the Applicant will focus in particular on independent
9 claims 1 and 10, as the Applicant believes those claims to be allowable over Olson and
10 Osogoshi. It is axiomatic that any dependent claim which depends from an allowable
11 base claim is also allowable, and therefore the Applicant does not believe it is necessary
12 to present arguments in favor of each and every dependent claim. The fact that the
13 Applicant has not presented herein specific arguments in favor of the allowability of each
14 and every dependent claim which depends from arguably allowable independent claim is
15 not to be considered as an admission that the dependent claims are only allowable as a
16 result of their dependence on an allowable base claim, but rather as a matter of
17 efficiency in responding to the instant Office action. The Applicant makes no concession
18 nor admission that any dependent claim is allowable based solely on its dependence
19 from an allowable base claim.

20
21 Claim 1

22 The Applicant contends that independent claim 1, and rejected claims 2-4 that
23 depend therefrom, are not anticipated by either Olson or Osogoshi. Claim 1 (as
24 amended above) recites:

25
(Continued on next page.)

1 A method of binding a plurality of sheets into a bound sheet stack,
2 comprising:

3 providing a first sheet and a second sheet;

4 printing on at least a portion of the first or second sheet;

5 following printing on the first or second sheet, applying a
6 protective coating to at least a portion of the first or second sheet;

7 following applying the protective coating, overlaying the first and
8 second sheets so that at least a portion of the protective coating on the at
9 least one sheet contacts the other sheet; and

10 following overlaying the first and second sheets, applying a binding
11 energy to a binding region defined on the first and second sheets to thereby
12 bind the sheets into a sheet stack, the binding region comprising a selected
13 area of the protective coating on the at least one sheet, the selected area
14 being in contact with the other sheet.

15 (Emphasis added.)

16
17 As can be seen, the sequence of forming the final sheet stack of Applicant's
18 claim 1 includes the sequential steps of first printing on one of the first or second sheets,
19 and then applying a protective coating to one of the sheets, and then overlaying and
20 binding the sheets. That is, the Applicant's method of claim 1 can generally be
21 summarized as, "print, *then* coat, then overlay and bind."

22 By contrast, Olson describes a coated sheet that can be printed, and *thereafter*
23 bound to another similar sheet. (See Olson Col. 2, lines 16-18 and 49-55.) That is,
24 Olson's method can be summarized as follows: "coat the sheet, then print the sheet,
25 then overlay the sheet with another sheet, then bind the two sheets." Put another way,
Applicant's claim 1 provides for "**print, then coat**, then bind", whereas Olson describes
"**coat, then print**, then bind."

1 In support of this position, the fact that Olson requires an opaque coating (see
2 Col. 3 lines 50-55 and 70-73) necessitates that the coating be applied to the sheet prior
3 to printing the sheet, else the coating would obscure any printing over which it was
4 applied. Thus, Olson does not describe (or allow for) the sheet to be coated after it has
5 been printed, as is required by Applicant's claim 1.

6 Further, the coating provided by Olson is not a protective coating (as required by
7 Applicant's claim 1), but is rather a coating intended to allow like-coated sheets to be
8 bonded together (see Col. 2 line 72 through Col. 3 line 2, and Col. 5 lines 15-23). That
9 is, Olson does not describe the coating as providing any "protective" capabilities (as
10 required by Applicant's claim 1) but rather as providing "bonding" capabilities, with no
11 regard as to whether the coating can or does provide any protective capabilities.

12 For at least these reasons the Applicant contends that Olson does not anticipate
13 Applicant's claim 1.

14 Osogoshi likewise does not describe a method wherein a protective coating is
15 applied to a first or second sheet following printing of the first or second sheet, as is
16 required by Applicant's claim 1. Rather, Osogoshi describes methods of (1) coating,
17 then bonding, then printing sheets, and (2) coating, then printing, then bonding sheets.
18 However, Osogoshi does not teach (or allow for) first printing and then coating the
19 sheets, as is required by Applicant's claim 1. Specifically, at paragraph [0014],
20 Osogoshi states (referring to the computer translated copy of JP 08052827 provided with
21 the Office action): "Thus, thermocompression bonding of the end section in which the
22 laminating only of the required number of sheets is carried out by the sheet of a sheet
23 ***ing before desired printing was given, or after printing is given, and the manufactured
24 coated paper subsequently has not printed is carried out by the heat press"
25 (Emphasis added.) This passage specifies that bonding can be applied post-printing, or
pre-printing, but in either case the coating is applied b for printing to "manufactured
coated paper". (See also paragraph [0001] of the computer translated copy of JP

1 08052827 provided with the Office action.) Accordingly, with respect to Applicant's
2 claim 1, Osogoshi essentially discloses no more than what is disclosed by Olson – that
3 is, the use of pre-coated paper in forming a bonded sheet stack, wherein the pre-coated
4 paper is subsequently printed and bonded. Osogoshi does not describe applying a
5 coating to a sheet, following printing of the sheet, as is required by Applicant's claim 1.

6 For at least these reasons the Applicant contends that Osogoshi does not
7 anticipate Applicant's claim 1.

8 The 35 U.S.C. § 102 rejection of claim 1 is thus unsupportable in view of the
9 requirements for such a rejection as described above. Thus, the Applicant contends that
10 claim 1 is allowable. As claim 1 is allowable, claims 3-4 are allowable by virtue of their
11 dependence upon an allowable base claim, as well as their own respective merits.

12
13 Claim 10

14 The Applicant contends that independent claim 10, and rejected claims 11 and 16
15 that depend therefrom, are not anticipated by either Olson or Osogoshi. Claim 10 (as
16 amended above) recites:

17
18 A method of producing a bound document, comprising sequentially:
19 providing a first sheet of media;
20 providing a second sheet of media;
21 generating an image on the first sheet of media;
22 applying a protective coating to the first sheet of media;
23 laying the second sheet onto the first sheet so at least a portion of
24 the protective coating on the first sheet contacts the second sheet; and
25 applying a binding energy to a preselected binding region of the first
and second sheets to thereby bind the sheets into a sheet stack.

(Emphasis added.)

1 As can be seen, the sequence of forming the sheet stack of Applicant's claim 10
2 includes the sequential steps of generating an image on a first sheet, then applying a
3 protective coating to the first sheet, and then overlaying and binding the sheets. That is,
4 the Applicant's method of claim 10 can generally be summarized as, "print, *then* coat,
5 then overlay and bind." On the other hand, and as described above with respect to
6 claim 1, both Olson and Osogoshi describe applying a coating to the sheet prior to
7 printing the sheet.

8 For at least these reasons the Applicant contends that Osogoshi does not
9 anticipate Applicant's claim 10. The 35 U.S.C. § 102 rejection of claim 10 is thus
10 unsupportable in view of the requirements for such a rejection as described above.
11 Thus, the Applicant contends that claim 10 is allowable. As claim 10 is allowable, claims
12 11 and 16 are allowable by virtue of their dependence upon an allowable base claim, as
13 well as their own respective merits.

14 15 Rejection of Claims under 35 U.S.C. § 103(a)

16 Claims 6-9, 12, 13 and 15 have been rejected under 35 U.S.C. § 103 as being
17 obvious over Olson and Osogoshi (separately).

18 The Applicant respectfully disagrees that claims 6-9, 12, 13 and 15 are obvious
19 as respectively described above.

20 It is a well known axiom of patent law that if an independent claim is allowable,
21 then any claim depending therefrom is also allowable (and therefore nonobvious).
22 Claims 6-9 depend from claim 1, and claims 12, 13 and 15 depend from claim 10. As
23 set forth above, the Applicant contends that claims 1 and 10 are allowable. Accordingly,
24 claims 6-9, and claim 12, 13 and 15, are allowable for at least the same reasons as set
25 forth above with respect to (respective) claims 1 and 10.

1 The Applicant further contends that claims 6-9, and claim 12, 13 and 15 are
2 allowable by virtue of their own respective merits, as elaborated in part hereafter.

3 As a starting point, MPEP 706.02(j) states:

4 "[t]o establish a *prima facie* case of obviousness, three basic
5 criteria must be met. First, there must be some suggestion or motivation,
6 either in the cited references themselves or in the knowledge generally
7 available to one of ordinary skill in the art, to modify the reference or to
8 combine the reference teachings. Second, there must be a reasonable
9 expectation of success. Finally, the prior art reference (or references
10 when combined) must teach or suggest all the claim limitations. The
11 teaching or suggestion to make the claimed combination and the
12 reasonable expectation of success must both be found in the prior art and
13 not based on applicant's disclosure." (Emphasis added.)
14

15 Claim 6

16 Claim 6 includes the following limitations:

17
18 The method of claim 1, and further comprising:

19 . . . providing a third sheet;

20 printing on at least a portion of the third sheet;

21 following printing on the third sheet, applying a protective coating to at
22 least a portion of the third sheet;

23 following applying a protective coating to at least a portion of the
24 third sheet, laying the third sheet onto the sheet stack . . . ; and

25 . . . applying the binding energy to the binding region to thereby bind
the third sheet to the sheet stack.

(Emphasis added.)

1 As can be seen, claim 6 includes the limitation of first printing on a third sheet,
2 and subsequently applying a protective coating to the third sheet prior to binding the
3 third sheet to the sheet stack. As described above with respect to claim 1, neither Olson
4 nor Osogoshi describe printing a sheet, let alone a third sheet in the final stack, *prior to*
5 applying a protective coating to the sheet.

6 Since neither Olson nor Osogoshi teach or suggest the limitations set forth in
7 Applicant's claim 6, the requirements for a 35 U.S.C. § 103 are not met, and the claim is
8 therefore allowable.

9
10 Claim 13

11 Claim 13 includes the following limitations:

12
13 The method of claim 12, and further comprising ***sequentially***:
14 providing a third sheet of media which is defined by a first edge;
15 *generating an image on the second sheet of media*;
16 *applying a protective coating to the second sheet of media*;
17 laying the third sheet onto the second sheet so at least a portion of
18 the protective coating on the second sheet contacts the third sheet and so
19 that the respective first edges of the sheets substantially coincide; and
20 applying the binding energy to the preselected binding area to
21 thereby bind the third sheet into the sheet stack.

22 (Emphasis added.)
23

24 As can be seen, claim 13 includes the limitation of first printing on the second
25 sheet of media (following printing on the first sheet of media, from claim 10), and
subsequently applying a protective coating to the second sheet prior to binding the third
sheet to the sheet stack. As described above with respect to claim 10, neither Olson nor

1 Osogoshi describe first printing a sheet, and then subsequently applying a protective
2 coating to the sheet, in conjunction with binding the sheet to a previously imaged sheet,
3 as is required by Applicants claim 13.

4 Since neither Olson nor Osogoshi teach or suggest the limitations set forth in
5 Applicant's claim 13, the requirements for a 35 U.S.C. § 103 are not met, and the claim
6 is therefore allowable.

7
8 Summary


9 The Applicant believes that this response constitutes a full and complete
10 response to the Office action, and therefore requests timely allowance of claims 1
11 through 16.

12 The Examiner is respectfully requested to contact the below-signed
13 representative if the Examiner believes this will facilitate prosecution toward
14 allowance of the claims.

15
16 Respectfully submitted,

17 Roland BOSS

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19 Date: December 19, 2003 By


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